

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: February 4, 2009
Electronic Signature for Megan E. Williams: /Megan E. Williams/

Docket No.: UMY-046
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kenan C. Murphy

Application No.: 10/789,186

Confirmation No.: 9606

Filed: February 26, 2004

Art Unit: 1636

For: REAGENTS FOR RECOMBINOGENIC
ENGINEERING AND USES THEREOF

Examiner: Nancy S. Vogel

MS Patent Extension
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT UNDER 37 CFR § 1.702(b)(2)

Dear Sir:

1. This statement is respectfully submitted in support of the “Application for Patent Term Adjustment Including Request for Reconsideration Under 37 CFR §1.705(b)” for the above-referenced application. In view of the following, it is respectfully requested that Applicants be granted a minimum patent term adjustment of **329 days**.

2. The patent term adjustment on the Determination of Patent Term Adjustment Under 35 U.S.C. §154(b) (“Determination”) that was attached to the Issue Notification is 258 days (a copy of the Determination is submitted herewith as Exhibit A). A copy of the PTO’s Patent Term Adjustment calculation (“PTA Sheet”) available on Private Pair is also submitted herewith as Exhibit B. Applicants respectfully submit that the determination of 258 days of patent term adjustment is incorrect for the reasons discussed below.

3. The factual bases for the above adjustment are set forth as follows:

A. Examination Delays Pursuant to 37 CFR §1.702 and §1.703

Pursuant to 37 CFR §1.703(f), the period of adjustment of the term of the patent under §1.702 is the sum of the periods of examination delay calculated under subparagraphs (a)-(e), to the extent that such periods are not overlapping, less the sum of the periods calculated under §1.704 (the period of Applicant Delay). In the above-referenced application, Applicants are entitled to a period of examination delay equal to the sum of the periods of delay under §1.703(a) and (b) for the reasons set forth below.

(i) “14 Month Delay” Pursuant to §1.703(a)(1)

In accordance 37 CFR §1.703(a)(1), Applicants are entitled to a period of patent term adjustment due to the failure by the Office to mail an action under 35 U.S.C. §132 not later than 14 months after the actual filing date (*i.e.*, by April 26, 2005). As shown in the PTO’s Patent Term Adjustment calculation (Exhibit B), the Office failed to mail an action under 35 U.S.C. §132 (a Restriction Requirement) until September 22, 2005. As such, Applicants are entitled to a period of patent term adjustment beginning April 27, 2005 and ending on September 22, 2005, the date of mailing of the Restriction Requirement by the Office. Accordingly, the period of patent term adjustment due to the 14 Month Delay by the Office is 149 days. This is consistent with the PTA Sheet (Exhibit B) from the Office.

(ii) “Three Years Delay” Pursuant to 37 CFR §1.703(b)

In accordance with the Issue Notification dated December 3, 2008, a patent is expected to issue on December 23, 2008. 35 U.S.C. §154(b) and 37 CFR §1.702(b), requires issuance of a patent within 3 years after the date on which the application was filed under 35 U.S.C. §111(a). In this case the Three Years Delay period began on February 26, 2007. As such, there is an actual anticipated delay of 666 days.

Additionally, Applicants respectfully note that a Notice of Appeal was filed on May 28, 2008. Pursuant to 37 CFR 1.702(b)(4) the requirement that the Office must issue a patent within 3 years after the date on which the application was filed under 35 U.S.C. §111(a) does not include the period of appellate review by the BPAI or a Federal Court. The present exclusionary period, in accordance with 37

CFR1.703(b)(4), begins with the filing of the Notice of Appeal and ends with the issuance of the Notice of Allowance on August 13, 2008 (*i.e.*, 78 days). Accordingly, the total delay of 666 days, after subtraction of the 78 day exclusionary period, provides for an anticipated Three Years Delay of 588 days.

(iii) Calculation of Total Period of Examination Delay Pursuant to 37 CFR §1.703(f)

As set forth in 37 CFR §1.703(f), the period of examination delay for this case is based on the grounds set forth in 37 CFR §1.702 is the sum of the period of 14 Month Delay (149 days) and the minimum period of Three Years Delay (588 days), or 737 days, to the extent these periods of delay are not overlapping. As the period of 14 Month Delay ended on September 22, 2005, prior to the first day of the period of Three Years Delay, *i.e.*, February 27, 2007, Applicants submit that these periods are not overlapping.

B. “Applicant Delay” Pursuant to 37 CFR §1.704

Pursuant to 37 CFR §1.704 the period of adjustment of the term of the patent due to examination delay is reduced by the period of Applicant Delay. As shown in the PTO’s Patent Term Adjustment calculation (Exhibit B), the Office has calculated a period of Applicant Delay of 408 days. Applicants seek no adjustment to the period of Applicant Delay.

(i) Applicant Delay for Responding to Notice to File Missing Parts Dated April 13, 2004

Applicants respectfully submit that a period of Applicant Delay of **122 days** accrued for the delayed submission of a Response on November 12, 2004. This is consistent with the PTA Sheet (Exhibit B) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 122 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(ii) Applicant Delay for Filing an Information Disclosure Statement

Applicants respectfully submit that a period of Applicant Delay of **99 days** accrued for the delayed submission of an Information Disclosure Statement (IDS) on March 1, 2006. This IDS was filed without a statement under 37 CFR §1.704(d), 99 days after the filing of a response by Applicants to the Restriction Requirement on November 22, 2005. This is consistent with the PTA Sheet (Exhibit B) from the Office. Pursuant to 37 CFR §1.704(c)(8), this 99 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(iii) Applicant Delay for Responding to Non-Final Action Dated March 8, 2006

Applicants respectfully submit that an additional period of Applicant Delay of **32 days** accrued for the delayed submission of an Amendment and Response on July 10, 2006. This is consistent with the PTA Sheet (Exhibit B) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 32 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(iv) Applicant Delay for Responding to Non-Final Action Dated October 2, 2006

Applicants respectfully submit that an additional period of Applicant Delay of **2 days** accrued for the delayed submission of an Amendment and Response on January 8, 2007. This is consistent with the PTA Sheet (Exhibit B) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 2 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(v) Applicant Delay for Responding to Non-Final Action Dated April 2, 2007

Applicants respectfully submit that an additional period of Applicant Delay of **63 days** accrued for the delayed submission of an Amendment and Response on September 10, 2007. This is consistent with the PTA Sheet (Exhibit B) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 63 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(vi) Applicant Delay for Responding to Final Action Dated November 26, 2007

Applicants respectfully submit that an additional period of Applicant Delay of **90 days** accrued for the delayed filing of an Amendment after Final and Notice of Appeal on May 28, 2008. This is consistent with the PTA Sheet (Exhibit B) from the Office. Accordingly, pursuant to 37 CFR §1.704(b), this 90 day period should be considered an Applicant Delay and should be added to the period of delay by Applicants.

(vii) Calculation of the Total Period of Applicant Delay

In view of the above, Applicants have calculated a total period of Applicant Delay of **408 days** which is the sum of the following Applicant Delays: (i) the 122 day period; (ii) the 99 day period ; (iii) the 32 day period; (iv) the 2 day period ; (v) the 63 day period; and (vi) the 90 day period. This is consistent with the PTA Sheet (Exhibit B) from the Office.

C. Calculation of Correct Patent Term Adjustment Pursuant to 37 CFR §1.702(f)

As set forth in 37 CFR §1.703(f), Applicants are entitled to a period of patent term adjustment equal to the period of examination delays reduced by the period of Applicant Delay. As such, Applicants submit that the correct patent term adjustment for the above-referenced application upon issuance of a patent as expected on December 23, 2008, is **329 days**, which is the difference between the total period of examination delay (737 days) and the period of Applicant Delay (408 days).

In view of the foregoing, it is respectfully requested that this Application for Patent Term Adjustment be favorably considered and that a corrected Determination of Patent Term Adjustment be issued to reflect a minimum patent term adjustment of **329 days**.

Dated: February 4, 2009

Respectfully submitted,

Electronic signature: /Megan E. Williams/

Megan E. Williams

Registration No.: 43,270

LAHIVE & COCKFIELD, LLP

One Post Office Square

Boston, Massachusetts 02109-2127

(617) 227-7400

(617) 742-4214 (Fax)

Attorney/Agent For Applicant